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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,483	10/18/2001	Lisa F. Frey	20569	7012

210 7590 08/20/2002

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EXAMINER

COVINGTON, RAYMOND K

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 08/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/982,483**

Applicant(s)

**Frey et al**

Examiner  
**Raymond Covington**

Art Unit  
**1625**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 7/22/02
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-30 are rejected under 35 U.S.C. 102(a) as being anticipated by Tillyer et al U.S. 6,046,327 . Tillyer et al teach a process for preparing cyclic compounds as claimed using a phosphate mediated cyclization process in the same manner as recited. See column 3, line 40 to column 4, line 76 and reaction schemes 1 and 4.

Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's comments have been noted and considered with the following effect. The claims are not enabled as there is no teaching or guidance that the placement of a heterocyclic ring or rings as substituents in the claimed moiety would possess the same properties as recited. This is particularly true in light of the limited examples in the application, which exemplify using cyclic "A" substituents.

In re Fouche 169 USPQ 422 CCPA (1971). Further more than routine experimentation is required. In re ~~Armbruster, 185 USPQ 152 (CCPA 1975)~~ and Angstadt 190 USPQ 214 CCPA (1976) not overruled.

The specification does not give any guidance as to how each of the heterocyclic substituted derivatives were prepared. In In re Wands, 8 USPQ2D 1400 (1988), factors

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to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quality of experimentation needed, and
8. the level of the skill in the art.

In the instant case, applicants are claiming heterocyclic substituted derivatives. Applicants have not disclosed any working examples, which would demonstrate, or guide, one skilled in the art as to how the heterocyclic substituted derivatives were prepared or obtained. The process of making the heterocyclic substituted derivatives or how the heterocyclic substituted derivatives were obtained is not readily apparent from the specification. The specification must teach how to make the invention. In re Gardner, 166 U.S.P.Q. 138 (1970). In order to practice the claimed invention, one skilled in the art would have to speculate how the heterocyclic derivatives were obtained or prepared. Therefore, the instant invention is not enabled. Claims limiting the scope of these terms should overcome this rejection.

The other claims are rejected as depending on the rejected base claims.

No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Covington whose telephone number is 703-308-4704. The examiner can normally be reached on Monday-Friday 9 am- 3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

*7/6*

Covington:mv  
August 12, 2002

*Alan L. Rotman*  
ALAN L. ROTMAN  
SUPERVISORY PATENT EXAMINER  
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